

### **Remarks**

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is requested.

Attached hereto is a page entitled "Version With Markings To Show Changes Made." Upon entry of this amendment, claims 1-2, 4, 10-12, 14, 16-21, 27-29, 32-33, and 50-58 will remain in this application. Claims 1, 10-12, and 27-29 have been amended herein. Claims 3, 5-9, 13, 15, 22-26, and 30-31 are canceled herein. Claims 34-49 have been previously withdrawn from consideration.

#### **1. Drawings**

The Examiner is thanked for the indication that the formal drawings previously submitted are acceptable.

#### **2. Claim Objections**

The Examiner has objected to claim 1 because of the presence of **[and]** in line 3. This **[and]** is deleted herein and the objection should, therefore, be withdrawn.

Claims 3, 8, 9, 13, and 25-26 have been objected to under 37 CFR 1.75(c). Claims 3, 8, 9, 13, and 25-26 have been cancelled herein. As such, the objections should be withdrawn.

#### **3. Claim Cancellations**

Claims 3, 5-7, 15, 22-24 and 31 were intended to be canceled in the previously entered response, but such a request was inadvertently included only in the body of that response. Therefore, the cancellation request is repeated herein. Additionally, Applicants wish to cancel claims 8-9, 13, 25-26 and 30 without prejudice or disclaimer herein. Thus, Applicants now wish to cancel claims 3, 5-9, 13, 15, 22-26, and 30-31.

#### **4. Claim Rejections -112**

The Examiner has rejected to claim 15 and 31 under 112, first para. Claims 15 and 31 have been cancelled herein. As such, the rejection of claims 15 and 31 should be withdrawn.

#### **5. Claim Dependency**

The Examiner has not entered the after final amendment because of the dependency in claims 10-12 and 27-29 would be improper following the cancellation of claims 9 and 26. The dependency of claims 10-12 and 27-29 has now been corrected herein by amendment.

#### 6. § 103 Rejections

The Examiner has rejected claims 50 and 53 under 35 U.S.C. §103(a) as being unpatentable for obviousness over Japanese Patent No. 02-258643 (Tsuji et al.) in view of US Patent No. 4,218,294 (Brack).

Claim 50 is allowable because none of the references, alone or in combination, teach or suggest applying a protective layer comprising a silane to a consolidated glass surface of the article used in the manufacture of an optical fiber. Specifically, Brack (US 4,218,294) teaches radiation curable release coatings (e.g., unsaturated prepolymers) that include a small amount (0.1 to 10%, preferably 0.5 to 4%) of a silane (see Col. 2, lines 1-10).

The Examiner asserts that Tsuji et al. teaches coating a silica-containing article used in the manufacture of optical fiber. Notably, Tsuji teaches a coating which is *easily peeled off* from the glass preform. Brack is directed to release coatings; a very specific type of coating. Release coatings are applied to a substrate and are not intended to be removed from the substrate. Release coatings function, and are intended, to allow other materials that are applied to the surface of the release coating to be easily removed (released) from the release coating. For example, a mold release coating is applied to a mold substrate and allows a molded article formed in the mold to be readily released therefrom. However, it should be recognized that release coating are designed to be securely attached to the substrate. Thus, Brack is directed to an entirely different problem, i.e., release coatings. Examiner states that one of ordinary skill in the art would modify Tsuji by adding a silane or a wax. However, there is *nothing in Tsuji* that would motivate such an addition. In particular, there is no discussion whatsoever in Tsuji that the materials employed by Tsuji lack peelability or are in need of further improvement. As such, there would be *no motivation* to modify Tsuji in the first place. Accordingly, there would be no motivation *to select* Brack in the first place. The only motivation to select Brack would be by using hindsight reasoning and Applicant's disclosure as the road map for making the modification. At best, it would be obvious to try the method claimed. Examiner is reminded that obvious to try is not the standard of patentability.

Furthermore, it is ill conceived that, if one of ordinary skill in the art were looking to modify a peelable coating, that one of ordinary skill would look to coatings which, in fact, are not designed to peel, i.e., release coatings for the way to improve them.

Finally, it is asserted that there is no reasonable expectation of success that adding such a material would, in fact, make a coating more peelable. This is mere supposition on the Examiner's part.

As such, the 103(a) rejection of claim 50 should be withdrawn. Claims 51-52 are allowable for at least those reasons.

Likewise, claim 53 is directed to a method including applying a protective layer comprising an alkyl ammonium compound, an aryl ammonium compound or a wax to a consolidated glass surface of the article. For the same reasons as given above for claim 50, claim 53 is also allowable. In particular, again, there is *nothing in Tsuji* that would motivate such an addition. There is no discussion whatsoever in Tsuji that the materials employed by Tsuji lack peelability or are in need of further improvement. As such, contrary to Examiner's assertion there would be *no motivation* to modify Tsuji in the first place. Accordingly, there would be no motivation *to select* Brack. The only motivation to select Brack would be by using hindsight reasoning and Applicant's disclosure as the road map for making the modification. At best, it would be obvious to try the claimed method.

Likewise, it is ill conceived that, if one of ordinary skill in the art were looking to modify a peelable coating, that such person would look to coatings which, in fact, are not designed to peel, i.e., release coatings for a way to improve them.

Finally, it is asserted that there is no reasonable expectation of success that adding such a material would, in fact, make a coating more peelable. This is mere supposition on the Examiner's part.

As such, the 103(a) rejection of claim 53 should be withdrawn.

The Examiner has rejected claims 54-57 under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Japanese Patent No. 02-258643 (Tsuji et al.) in view of US Patent No. 5,739,191 (Woodhall et al.).

Tsuji teaches a *easily peelable polyvinyl system*. Note that Tsuji *does not* specifically teach the use of polyvinyl alcohol (a water soluble coating). Woodhall teaches a masking material readily removable with water or by peeling from a work surface to be painted or mechanically processed. Note that there is no suggestion in Woodhall to use a coating for protection of an optical fiber article. Thus, there is no requisite suggestion in the art that the claimed process should be carried out, i.e., coating a silica-containing article used in the manufacture of optical fiber with a protective organic layer and then at least partially removing by washing during subsequent processing of the article. Thus, the claimed method subject matter, as a whole, is not suggested by the prior art.

Most importantly, there is no motivation, contrary to Examiner's assertion, that the Tsuji reference is in any need of improvement. Tsuji is directed to an *easily* peelable coating. In other words, the Tsuji method works adequately. There is no motivation to select Woodhull in the first place as the method is *not in need of improvement*. As such, the references as a whole would not suggestion making the modification. At best, Examiner has shown that it might be obvious to try the method taught in Woodhall on a silica-containing article used in the manufacture of optical fiber. However, it is well settled that "obvious to try" is not the standard of patentability. Accordingly, the obviousness rejection of claim 54 should be withdrawn. Claims 55-57 are allowable for at least these reasons.

### **7. Obviousness-Type Double Patenting**

The Examiner states that claims 1-16, 18-32 and 50-58 are provisionally rejected as being unpatentable over claims 1-28 of co-pending application No. 09/569,562. In reviewing MPEP 804 1.B regarding obviousness-type double patenting rejections between two applications filed by a common assignee, the courts have sanctioned making the applicant aware of potential double patenting issues by allowing provisional double patenting rejections. This allows the party to address the merits of the rejection during the pendency of the applications. However, it seems in this case, that the appropriate action is to address the merits of the double patenting rejection only in the later filed case (09/569,562). Applicant's recognize that the Examiner should continue to make the rejection until the present case is in a condition for allowance (other than for the provisional double patenting issue) and then Examiner should withdraw the rejection and permit the present application to issue into a patent while converting the provisional rejection in the other case (the 09/569,562) into an actual double patenting rejection which then will be addressed in that later filed case. Note also, it is improper to reject, based upon obviousness, an earlier filed case based upon a later filed application. This is because any determination of obviousness must be made at the time of filing of the first case.

### **8. Conclusion**

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1, 2, 4, 10-12, 14, 16-21, 27-29, 32-33, and 50-58 and a prompt Notice of Allowance thereon.

Applicant believes that a three extension of time is necessary to make this Response timely. A petition for an extension of time is proved herewith. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

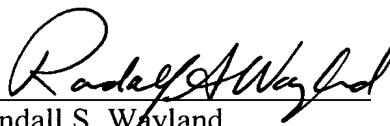
Please direct any questions or comments to Randall S. Wayland at 607-974-0463.

Respectfully submitted,

CORNING INCORPORATED

Date: \_\_\_\_\_

3/13/03



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims**

(Twice Amended) 1. A method of protecting a silica-containing article used in the manufacture of an optical fiber, the method comprising the steps of:

providing a silica-containing article used in the manufacture of an optical fiber;

**[[and]]**

applying a protective organic layer to the silica-containing article;

removing, by cleaning, particulates from the protective layer; and

ablating by heating the protective layer during subsequent processing of the silica-containing article.

(Amended) 10. The method of claim [9] 1, wherein the protective layer includes at least one of a water soluble polymer, a thermoplastic polymer, a latex based polymer, a thermoset polymer, and a UV curable polymer.

(Amended) 11. The method of claim [9] 1, wherein the organic material forms a self-assembled monolayer on the silica-containing article.

(Amended) 12. The method of claim [9] 1, wherein the organic material includes at least one of hydrocarbon silane, fluorocarbon silane, epoxy functional silanes, acrylate functional silane, amine functional silane, thiol functional silane, phenyl functional silane, an alkyl and aryl ammonium compound, acrylate polymer, polyvinyl alcohol, and a wax.

(Amended) 27. The method of claim [26] 1, wherein the protective layer includes at least one of a water soluble polymer, a thermoplastic polymer, a latex based polymer, a thermoset polymer, and a UV curable polymer.

(Amended) 28. The method of claim [26] 18, wherein the organic material forms a self-assembled monolayer on the fiber preform.

(Amended) 29. The method of claim [26] 1, wherein the organic material includes at least one of hydrocarbon silane, fluorocarbon silane, epoxy functional silanes, acrylate

functional silane, amine functional silane, thiol functional silane, phenyl functional silane, an alkyl and aryl ammonium compound, acrylate polymer, polyvinyl alcohol, and a wax.

Please cancel claims 3, 5-9, 13, 15, 22-26, and 30-31.